

09/474,317

12961

REMARKS

Claims 1 to 26 are pending in this application. Claims 1 to 26 stand rejected under final Office Action under section 103(a). In response, a Request for Continued Examination has been contemporaneously filed, and independent claims 1, 7, 10, 11, 14, 17, 20 and 22 are amended.

Comments as to all Claims

Claims 1 to 26 stand rejected under section 103(a) as being unpatentable over Gabbard et al (US 6,205,432) and in view of Eggleston et al (US 6,101,531).

Respectfully, Applicant points out that:

- (1) the digital files of the present invention are *in transit* and must be communicated without alteration to a next Internet leg in the transmission path of the file;
- (2) Gabbard et al and Eggleston et al teach away from the unaltered retransmission of the digital files; and
- (3) The amendments to the independent claims make it clear that the received in transit data is transmitted unaltered by the practice of the invention.

The Digital Files Of The Present Invention Are In Transit

The specification makes it clear that the digital files of interest in the invention are in transit over the Internet:

"at step 135 all of the packets received from server 205 are forwarded by monitor 210 to router 215, which send them to the next appropriate Internet leg in the packets' transmission path through the Internet 220." (p. 6, ll. 22-24)

As is evident from Figure 1, the file received by the ISP at step 130 is retransmitted without alteration in step 135. Further, the capturing and checking done in

09/474,317

12961

steps 140 and 150 do not alter the file that has been routed by the ISP to its destination in step 135.

The packets are clearly "transiting through" the monitor sites, and thus are to be sent on their way without modification.

Gabbard *et al* And Eggleston *et al* Teach Away From The Unaltered Retransmission Of The Digital Files

Gabbard *et al* discloses an advertisement system and method for inserting into an end user communication message a background reference to an advertisement. In other words, Gabbard *et al.* alters the digital file being transmitted:

"A message server *inserts the background reference* after receiving a message originally sent from an end user originator and *before sending the message to be delivered* to an end user recipient." (c. 4, ll. 12-15)(emphasis added)

Gabbard *et al* goes even further, and can even convert the message into a format not originally sent by the sender:

"When necessary, *the message server will convert at least a portion of the message* into a proper format, such as HTML, before inserting the background reference to an advertisement, which is preferably selected in accordance with end user recipient demographic information and/or ad exposure statistics." (c. 4, ll. 16-21)(emphasis added)

The intrusion upon the communication is intended, as it is noted:

"the user may also be initially surprised to see an advertisement in the background of an e-mail message which may be from a known originator, thus increasing the awareness and exposure." (c. 4, ll. 46-49).

Clearly, a limitation that the message be retransmitted unaltered would defeat the

09/474,317

12961

very purpose of Gabbard et al; *its very purpose is to alter the captured message*. Since Gabbard et al teaches the alteration of received packets and digital files, it certainly teaches away from the present invention.

Eggleston et al. discloses a system for communicating user-selected criteria filters for filtering data transferred from a host, to "limit the amount of information communicated between a remote user and host." (c. 1, 56-58). The problem to be solved is how to filter the message traffic:

"Unfortunately, typical applications like email do not provide for user-selected methods for choosing and limiting the volume of down-loaded communications, or for filtering uploaded communications. Thus, a user who wants to receive remote messaging is left with an option of receiving all his messages, even the ones he or she might otherwise be willing to leave unread until a later time when no longer using expensive remote communications services. Further, many processes, like that of a typical email reply, are wasteful of bandwidth by resending all earlier messages each time a new reply is generated, even though the earlier messages may still be stored at both ends of the wireless network." (c. 1, 60 to c. 2, 11. 5).

In its first main embodiment, Eggleston et al teaches a communication system with a separate communications server 110 for redirecting the messages in a sessionless data flow to a user 105. (c. 4, 11. 9-56). This redirection of messages thus teaches away from the retransmission of received packets unaltered to a next Internet leg in the transmission path of the file.

In its second main embodiment, a filter is used to intercept messages and prevent transmission:

"a prestage filter stage is provided for applying user-definable filter parameters (e.g., reject, pass, or granularity filters) on data being

09/474,317

12961

transferred between the remote communication unit and communication server. For downloading, e.g., email from a host post office, a communication server controller preferably either forwards the filter parameters in a query object or message to the post office to apply and return qualified mail, or the communication server receives all unprocessed mail and applies the filters locally, only acknowledging as processed that mail which is qualified. For uploading, e.g., email from a client, a client controller applies an upload prestage filter so as to retain all filter rejected mail, while transmitting mail passing the filters. Thus, only desired data transfers (i.e., those meeting user defined filters) are communicated over the expense-bearing networks between the remote unit and communication server." (c. 3, ll. 4-20)

The interception of messages teaches away from the retransmission of received packets unaltered to a next Internet leg in the transmission path of the file.

Similarly, the other embodiments teach transfer filtering (c. 3, ll. 21-39), optimized reply construction (c. 3, ll. 40-61), and communication restriction at usage limits. (c. 3, ll. 62-67). All of these teach away from the retransmission of received packets unaltered to a next Internet leg in the transmission path of the file.

Accordingly, neither Eggleston et al and Gabbard et al teach, nor fairly suggest sending received packets unaltered to a next Internet leg in the transmission path of the file. In fact, one of ordinary skill would be led by Eggleston et al and Gabbard et al in a divergent direction, e.g., modification and/or interception. See *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 45 USPQ2d 1977 (Fed. Cir. 1998).

Respectfully, Applicant points out that the Examiner has not identified any reason to combine the Eggleston et al and Gabbard et al references, other than that they are both concerned with e-mail transmission. One should not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other

09/474,317

12961

parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *See Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed Cir. 1986).

The Amendments Make It Clear That The Received In-Transit Data Packets Are Unaltered By The Practice Of The Invention.

The amendments to the independent claims make it clear that the in transit received data packets are unaltered by the practice of the invention. As noted above, no new matter is introduced by these amendments, and support is found in Figure 1 and throughout the specification.

Claims 1, 11, 17, and 22

Claims 1, 11, 17 and 22 have been amended by adding the explicit step; "sending the received packets unaltered to a next Internet leg in the transmission path of the file."

Exemplary is claim 1:

1. (Currently amended) A method for tracking the transmission of a digital file over the Internet comprising the steps of:

receiving packets constituting segments of the file in transit over the Internet;

examining file headers in said packets to determine the presence of specific identifying indicia therein; and

recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia; and

sending the received packets unaltered to a next Internet leg in the transmission path of the file.

Claims 7 and 20

Claims 7 and 20 have been amended to clarify that the router routes packets comprising the file unaltered to a next Internet leg in the transmission path of the file.

09/474,317

12961

Exemplary is claim 7:

7. (Currently amended) A system for tracking an Internet transmission of a digital file containing identifying indicia in a file header, the system comprising:

- a server which receives the file;
- a router which routes packets comprising the file unaltered to a next Internet leg in the transmission path of the file; and
- a monitor, connected between said server and said router, which processes packets constituting segments of the file;

wherein said monitor is programmed to:

- examine file headers in said packets to determine the presence of said identifying indicia therein; and
- record the source Internet address for said file for each of the packets containing said identifying indicia.

Claim 10

Claim 10 had been amended to require means for sending the received file unaltered to a next Internet leg in the transmission path of the file. Claim 10 now reads:

10. (Currently amended) A system for tracking an Internet transmission of a digital file containing identifying indicia in a file header, the system comprising:

- a modem which receives the file;
- a server for processing the file; and
- a monitor, connected between said modem and said server, which processes packets constituting segments of the file; wherein said monitor is programmed to:

- examine file headers in said packets to determine the presence of said identifying indicia therein; and
- record the source Internet address for said file for each of the

09/474,317

12961

packets containing said identifying indicia; and
means for sending the received file unaltered to a next Internet leg in
the transmission path of the file.

Claim 14

Claim 14 had been amended to require that the data communications monitoring device capture packets of information being transmitted via the Internet without alteration of the captured packets. Claim 14 now reads:

14. (Currently amended) A method for tracking the transmission of a digital file over the Internet comprising the steps of:
- placing identifying indicia in said digital file;
 - using a data communications monitoring device to capture packets of information being transmitted via the Internet without alteration of the captured packets;
 - examining certain ones of said packets to determine the presence of said identifying indicia in said file; and
 - recording the source and destination Internet addresses for each of the packets containing said identifying indicia, and the identity of the file associated therewith.

It is respectfully noted that all the independent claims now distinguish over the Eggleston et al and Gabbard et al references, and are allowable.

DEPENDENT CLAIMS

The independent claims being allowable, the dependent claims 2-6, 8, 9, 12, 13, 15, 16, 18, 19, 21, and 23-26 are believed to be allowable based on the subject matter of claims 1, 7, 11, 14, 17, 20, and 22 from which they depend, and because they further limit allowable subject matter.

09/474,317

12961

CONCLUSION

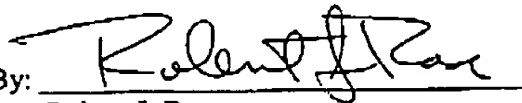
Accordingly, it is believed that the rejection of claims 1-26 under 35 U.S.C. 103 have been overcome by the amendment and remarks; allowance thereof is respectfully requested.

In view of the above, it is believed that this application, including each of the claims 1-26, is in condition for allowance. Such allowance is respectfully requested. If for some reason the Examiner considers otherwise, it is respectfully requested that a telephone call be placed to the undersigned so that issuance of a patent can be expedited.

The Commissioner is authorized to charge the cost of the Request for Continued Examination, and a three month extension to Deposit Account No. 19-2090. The Commissioner is hereby authorized to charge any additional fees, or credit any overpayments, associated with this communication to Deposit Account Number 19-2090.

Respectfully submitted,
SHELDON & MAK PC

Date: 12-1-03

By: 
Robert J. Rose
Reg. No. 47,037

SHELDON & MAK PC
225 South Lake Avenue, 9th Floor
Pasadena, California 91101-3005
Telephone (626) 796.4000
Facsimile (626) 795.6321